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Paper No. 11

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FEB 17 2004

OFFICE OF PETITIONS

In re Application of :
Itoh, et al. :
Application No. 10/060,765 : ON
Filed: January 29, 2002 : PETITION
Attorney Docket No. 201130.408D1 :
FOR: HUMAN FGF-21 GENE AND GENE EXPRESSION PRODUCTS

This is a decision on the petition under 37 CFR 1.137(a), filed February 2, 2004, to revive the above-identified application. In the alternative, petitioner requests revival under 37 CFR 1.137(b).

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The petition under 37 CFR 1.137(b) is **GRANTED**.

The above-identified application became abandoned for failure to timely reply to Restriction Requirement, mailed June 11, 2003, which set a period for reply of one (1) month. No timely reply was filed. Thus, this application became abandoned on July 12, 2003. A Notice of Abandonment was mailed on December 17, 2003.

Petitioners allege that the June 11, 2003 Restriction Requirement was not received at the correspondence address of record.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof; (2) the petition fee as set forth in § 1.17(l);[1] (3) a showing to the satisfaction of

[1] The petition fee of $110.00 for requesting revival under 37 CFR 1.137(a) will be charged to deposit account no. 04-0258.

the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section. This petition does not satisfy requirement (3).

With respect to (3), the showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

The Commissioner may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable". 35 USC § 133. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term 'unavoidable' "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

The showing required to establish nonreceipt of an Office communication must include:

1. A statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received.
2. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.

A review of the record indicates no irregularity in the mailing of the June 11, 2003 Restriction Requirement, and in the absence of any irregularity there is a strong presumption that the communication was properly mailed to applicants at the correspondence address of record. This presumption may be overcome by a showing that the aforementioned communication was not in fact received.

Petitioners have not proven nonreceipt because practitioners did not include a statement that a thorough search of the file jacket and docket records was conducted. The Seed Intellectual Property Law Group, PLLC (Seed) was responsible for processing and docketing Office

correspondence at the time the June 11, 2003 Restriction Requirement was mailed. The current group of attorneys did not directly receive Office correspondence until December 2003. Seed is the only entity that can attest to the events that transpired around June 11, 2003 with respect to the search of the file jacket and docketing procedures.

The petition under 37 CFR 1.137(a) is **dismissed**.

Petitioners have submitted a reply in the form of a response to the Restriction Requirement, an acceptable statement of the unintentional nature of the delay in responding to the June 11, 2003 Restriction Requirement, and the $,1330.00 petition fee.

The petition under 37 CFR 1.137(b) is **granted**.

After the mailing of this decision the application will be forwarded to Technology Center 1600's technical support staff for entry of the response to the Restriction Requirement filed on February 2, 2004 and further examination.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 308-6712.

E. Shirene Willis

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